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PATENT

Attorney Reference Number 6424-61326-01
Application Number 10/035,814

Remarks:

Reconsideration of the application is respectfully requested in view of the foregoing amendments and following remarks. Claims 1-47, 55-56, 59-67, 70, 72, 87-92 and 94 are pending in the application. No claims have been allowed. Claims 1, 33, 41, 46, 55, 56, 59, 63, 70, 72, 87, and 94 are independent.

Interview Summary

Applicant wishes to thank Examiner Pramila Parthasarathy for her time during a telephonic interview on July 14, 2005. Possible amendments to claim 1 and the cited art were discussed.

Cited Art

The Action cites various patent documents, including:

U.S. Patent No. 6,640,211 to Holden ("Holden");

U.S. Patent No. 6,670,731 to Huff ("Huff");

U.S. Patent No. 5,659,741 to Eberhardt ("Eberhardt"); and

U.S. Patent No. 6,757,720 to Weschler, Jr. ("Weschler").

Patentability of Claims 1-32 over Holden, Huff, Weschler, and Eberhardt under § 103

The Action rejects original claim 1 over Holden. In an effort to expedite prosecution to find mutually-agreeable allowable subject matter, Applicant has now added language similar to that found in claims 63-65 into claim 1. Claims 63-65 were rejected over combinations of Holden, Huff, Weschler, and Eberhardt.

As amended, claim 1 now recites in part:

wherein the group is designated for members interested in avoiding or treating a particular medical condition, the genomic profile information system is operable to provide group members with access to genomic profile information group functions and information, and the members comprise at least one of the participants . . .

For example, the Application describes at Page 11, lines 23 et seq.:

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Still another way to motivate participants to contribute their information is by providing group information and functions. Groups can be created to focus on particular characteristics or conditions related to genomic or molecular profiles. For example, a group can be designated for members interested in avoiding or treating illness and diseases, such as breast cancer, diabetes, ... Participants can join the group to share information and ideas.

Applicant believes such an arrangement is a particularly innovative approach. For example, providing participants with access to group information and functions (e.g., exchanging information with other group members) enables collective action by a group of persons who are particularly motivated by self-interest to determine how to avoid or treat a particular medical condition. As understood by Applicant, the cited references, alone or combined, fail to teach or suggest such an arrangement.

The Action acknowledges that Holden and Huff lack the description of the recited groups and relies instead on Weschler and Eberhardt in combination with Holden and Huff. The amended claim, however, recites an arrangement not taught or suggested by these references, alone or in combination.

Weschler's description of groups would not lead one to the recited "the group is designated for members interested in avoiding or treating a particular medical condition." At column 11, lines 60 et seq., Weschler describes:

Group plug in 322 is used to define and manage group specifications in profile service 301. A group is an organizational entity that includes members that have shared attribute information by virtue of their membership. A group may be, for example, a workgroup or team within an organization, a suite of software applications, a group of hard disk drives that form a RAID storage set, and the like. The members of each group may share specified privileges or have specified restricts imposed on them.

Thus, Weschler does describe "[a] group is an organizational entity that includes members that have shared attribute information by virtue of their membership." However, a mere mention of "shared attribute information" would not lead one of skill in the art to all possible attributes, and certainly not to "members interested in avoiding or treating a particular medical condition" as recited in claim 1. As understood by Applicant, Weschler is concerned with workgroups or teams within an organization, not medical conditions. Thus, even if Weschler were combined with Holden and Huff, it would not lead to the recited arrangement.

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Eberhardt's description of a group of patients would not lead one to the recited "provide group members with access to genomic profile information group functions and information."

At column 8, lines 34 et seq., Eberhardt describes:

It is considered that this function of the CS of this invention will provide means whereby, for the first time in history, the reactions (good, bad or none) of a very large group of patients taking a given medicine can be monitored continuously by computer and then the results can be rapidly reported to the pharmaceutical or other manufacturer of the medication. This is in contrast to the present system wherein drug companies do not have any systematic means for collecting on-going information from persons using their drugs.

Thus, Eberhardt does describe "group of patients taking a given medicine can be monitored continuously by computer." However, one of skill in the art would not be led to "provide group members with access to genomic profile information group functions and information" from a mere mention of a group of patients. The passage in Eberhardt does not teach or suggest that *members in the group could access their information via a system such as that recited in claim 1.*

Eberhardt's description of a user activating a New Record Window key does not teach or suggest the recited "provide group members with access to genomic profile information group functions and information." Eberhardt goes on to discuss further details at column 11, lines 35 et seq.:

If the user activates the New Record Window Key, moves the cursor to a field within the record, and clicks the mouse button, text can be entered into that field, primarily about the patient.

However, "the user" still does not teach or suggest "provide group members with access." Eberhardt does not describe that members in the group are provided with access to the described software system.

For at least these reasons, claim 1 and its dependent claims, 2-32, are allowable over Holden, Huff, Weschler, and Eberhardt.

Patentability of Claims 63-67

Unamended claim 63 recites:

storing a personal genomic profile for a participant in a database;
designating the participant as a member of a group; and
providing the participant with access to group functions and information.

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Because Applicant does not find in Holden, Huff, Weschler, and Eberhardt a description of "providing the participant with access to group functions and information," Applicant thus believes the claim is allowable in its present form. Accordingly, claim 63 and its dependent claims 64-67 are allowable over the references.

The Remaining Claims

In the interest of brevity, Applicant simply points out that the other independent claims have had language added to them regarding "groups." Each of the claims is thus patentable over Holden, Huff, Weschler, and Eberhardt.

Objection to Incorporation by Reference

Applicant acknowledges the objection to the incorporation by reference. Applicant has not yet identified any essential material required from the incorporated documents and therefore does not present any amendments to the specification at this time.

Request for Interview

If any issues remain, the Examiner is formally requested to contact the undersigned attorney prior to issuance of the next Office Action in order to arrange a telephonic interview. It is believed that a brief discussion of the merits of the present application may expedite prosecution. Applicant submits the foregoing formal Amendment so that the Examiner may fully evaluate Applicant's position, thereby enabling the interview to be more focused.

This request is being submitted under MPEP § 713.01, which indicates that an interview may be arranged in advance by a written request.

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Conclusion

The claims in their present form should now be allowable. Such action is respectfully requested.

Respectfully submitted,

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